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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,341	03/09/2000	David Leigh Donoho	UNIV0001	3293
22862	7590	09/02/2004	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			CARDONE, JASON D	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,341

Applicant(s)

DONOHO ET AL.

Examiner

Jason D Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 24-36, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Attached Office Action</u> . |

DETAILED ACTION

1. Claims 16-23 and 37-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
2. Claims 1-15, 24-36, 45 and 46 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-15, 24, 25, 28-36, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canale et al. ("Canale"), USPN 5,619,648, in view of Salimando et al. ("Salimando"), USPN 6,185,599.
5. Regarding claim 1, Canale discloses an advice consumer for gathering broadcast information from a communications medium and a reader associated with the advice consumer for determining relevance of the broadcast information, a communications system comprising: an advice provider which delivers information over a communications medium to target situations based on an arbitrary combination of

computationally verifiable conditions of an advice consumer computer and its environment [Canale, col. 3, line 31 – col. 4, line 33];

wherein the advice consumer is advised of the information only if the information meets certain predetermined relevance criteria [Canale, col. 3, line 54 – col. 4, line 33, col. 5, line 65 – col. 6, line 26, and col. 8, lines 24-28];

the advice provider offers highly targeted advice without compromising individual privacy; and the environment includes data of a sensitive or private nature [Canale, col. 6, lines 1-9, col. 7, lines 1-6, and col. 10, lines 25-33].

Canale does not specifically disclose the advice provider broadcasts information. However, Salimando, in the same field of advise providing endeavor, discloses advice provider broadcasting information to target situations [Salimando, col. 1, lines 16-67 and col. 2, line 54 – col. 3, line 18]. It would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate broadcasting, taught by Salimando, into the locate-expertise system, taught by Canale, in order send the advise out for other consumers.

6. Regarding claim 2, Canale-Salimando further discloses the relevance criteria further comprising: a set of any of demographic, biologic, geographical, and other empirical models used to infer statistically that a certain condition is highly likely to be true, even when it cannot be verified by direct calculation, measurement, or formal logical deduction, by using any of information which may be publicly available, information present in a user profile, information directly measurable, or information

available from third parties [Canale, col. 5, line 65 – col. 6, line 26] [Salimando, col. 4, lines 20-59].

7. Regarding claims 3 and 4, Canale-Salimando further discloses financial and transaction data [Canale, col. 9, lines 57-67] [Salimando, col. 13, line 41 – col. 14, line 59].

8. Regarding claim 7, Canale-Salimando further discloses an inspector library containing executable code which is invoked as part of a continual relevance evaluation process; and one or more remote inspector methods for remotely performing any of mathematico-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage devices, and querying the communicating devices [Canale, col. 9, line 30 – col. 10, line 33] [Salimando, col. 2, line 54 – col. 3, line 18]

9. Regarding claim 8, Canale-Salimando further discloses the one or more remote inspector methods comprising remote financial records inspectors [Canale, col. 5, lines 16-25 and col. 9, lines 57-67] [Salimando, col. 13, line 41 – col. 14, line 59].

10. Regarding claims 9, 14 and 15, Canale-Salimando further discloses the one or more remote inspector methods comprise any of server side components and client side components, a connection between the client and the server is secured by a

cryptographic protocol, and the identity of a client requesting information is authenticated by a server using an authentication protocol [Canale, col. 6, lines 1-9, col. 7, lines 1-6, and col. 10, lines 25-33] [Salimando, col. 2, line 54 – col. 3, line 18 and col. 13, line 41 – col. 14, line 59].

11. Regarding claims 10 and 11, Canale-Salimando further discloses the one or more remote inspector methods comprise server side components for providing remote information access, wherein a consumer receives advice via the remote information access, and the consumer's personal information is included in the server side components, only if the consumer authorizes inclusion of the consumer's personal information in the server side components [Canale, col. 6, lines 1-9, col. 7, lines 1-6, and col. 10, lines 25-33] [Salimando, col. 2, line 54 – col. 3, line 18 and col. 13, line 41 – col. 14, line 59].

12. Regarding claim 12, Canale-Salimando further discloses a consumer subscribing to advice sites, which make use of the remote inspectors [Canale, col. 3, line 54 – col. 4, line 33, col. 5, line 65 – col. 6, line 26, and col. 8, lines 24-28] [Salimando, col. 2, line 54 – col. 3, line 18].

13. Regarding claim 13, Canale-Salimando further discloses a remote inspector method on a consumer machine establishes a connection with an information server and performs one or more queries to determine if relevant information is present on the

information server with regard to the consumer; and wherein the information is gathered by the server [Canale, col. 3, line 54 – col. 4, line 33, col. 5, line 65 – col. 6, line 26, and col. 8, lines 24-28] [Salimando, col. 4, lines 20-59].

14. Regarding claims 24, 25, 28-36, 45 and 46, claims 24, 25, 28-36, 45 and 46 have similar limitations as claims 1-4 and 7-15. Therefore, the similar limitations are disclosed under Canale-Salimando for the same reasons set forth in the rejection of claims 1-4 and 7-15 [Supra 1-4 and 7-15].

15. Claims 5, 6, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canale-Salimando as applied to claims 1 and 24 above, and further in view of Cohen, USPN 5,633,910.

16. Regarding claim 5, 6, 26 and 27, Canale-Salimando substantially discloses the present invention but does not specifically disclose medical data, wherein the relevance criteria comprise assertions that certain combinations of prescription drugs. However, Cohen, in the same field of endeavor, discloses advice messages on medical data, wherein the relevance criteria comprise assertions that certain combinations of prescription drugs [Cohen, col. 14, line 33 – col. 15, line 52]. It would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate medical advise, taught by Cohen, into the locate-expertise system, taught by Canale-Salimando, in order send the advise of medicine to consumers.

Response to Arguments

17. Applicant's arguments filed 5/18/2004 have been fully considered but they are not persuasive.

(A) Salimando is not prior art under 35 USC 103 because its filing date of 11/19/97 is not one year earlier than the provisional application that is claimed benefit, filed 9/1/98.

As to point (A), under 35 USC 102 (b), the prior art was patented or published more than one year prior to the application for patent but under 35 USC 102 (e), the prior art has to be patented or published before the filing date (not one year before). 35 USC 103 comes from 102 and the prior art has to be patented or published before the filing date (not one year before). Therefore, Salimando would not have been shown under 35 USC 102 (b) but under 35 USC 102 (e) and therefore is prior art under 35 USC 103.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

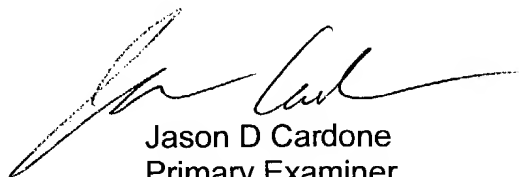
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

September 2, 2004